

DOCKET NO.: PRES06-00163  
Customer No.: 23990



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of : RONALD A. SCHACHAR  
U.S. Serial No. : 09/556,143  
Filing Date : April 21, 2000  
Examiner : David M. Shay  
Group Art Unit : 3739  
Title : SEGMENTED SCLERAL BAND FOR TREATMENT OF  
PRESBYOPIA AND OTHER EYE DISORDERS

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION UNDER 37 C.F.R. § 1.144**

Pursuant to 37 C.F.R. § 1.144, Applicant petitions from the pending restriction requirement entered March 24, 2003 in the above identified invention.

Restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01.

The Restriction Requirement characterizes claims 45–46 as directed to an invention that is independent or distinct from the invention originally claimed “for the following reasons: the apparatus could be used for a substantially different method, such as transmyocardial revascularization.” (Page 2, Office Action of March 24, 2003) (emphasis added).

DOCKET NO. PRES06-00163  
SERIAL NO. 09/556,143  
PATENT

Claims 45–46 are directed to a method, not to an apparatus as stated in the Office Action.

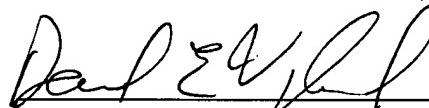
In addition, each of claims 45–46 recite ablation or laser irradiation of the sclera and ciliary body/muscle of an eye. These structures play NO ROLE in “transmyocardial revascularization,” which involves the heart. The arguments advanced by the Examiner are therefore completely baseless, and are arbitrary and capricious.

Applicant requests that the restriction requirement be withdrawn.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.



Daniel E. Venglarik  
Registration No. 39,409

Date: 1-29-03

P. O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3600 (voice)  
(972) 628-3616 (fax)  
*Email: dvenglarik@davismunck.com*

Asserted “New Matter”

U.S. Patent 5,354,331

with the ray that strikes the atom; all the rays are in step, and the beam becomes bright enough to pass through the semi-silvered mirror and leave the laser; the energy is as laser light.

Turning to FIGURE 11, shown is an exemplary flow diagram (generally designated 1100) of an exemplary method of operating a laser in accordance with the principles of the present invention. The discussion of FIGURE 11 is made concurrently with reference to FIGURE 10 and laser 1000.

Exemplary method 1100 operates laser 1000 to treat presbyopia, hyperopia, primary open angle glaucoma and hypertension and more particularly to methods of treating these diseases by increasing the effective working distance of the ciliary muscle.

Initially laser 1000 is enabled, causing laser beam generator 1020 to generate a laser beam whose intensity is controlled by controller 1030 (process step 1110).

Laser 1000 is used to irradiate the sclera of an eye in the region of the ciliary body in accordance with the principles of the present invention to thereby weaken the sclera of the eye and to increase the effective working distance of the ciliary muscle of the eye (Step 1120).

This step of irradiating the sclera of an eye in the region of the ciliary body may comprise (i) abrading the sclera with laser irradiation; (ii) ablating the sclera with laser

This invention relates to methods of treating presbyopia, column 1, lines 7–12  
hyperopia, primary open angle glaucoma and ocular hypertension and more particularly to methods of treating these diseases by increasing the effective working distance of the ciliary muscle.

Alternatively the sclera in the region overlying the ciliary muscle can be weakened by irradiation with a laser beam . . .  
The invention also relates to increasing the amplitude of accommodation of the eye by increasing the effective working range of the ciliary muscle.

Alternatively, the sclera in the region of the ciliary column 8, lines 26–28  
body may be weakened by surgical means. The sclera may be lines 3–12 thinned or weakened by the surgical removal of a portion of and 26–29

### Asserted “New Matter”

U.S. Patent 5,354,331

irradiation; (iii) incising the sclera with laser irradiation its collagenous substance, as, for example by ablating a portion of the thickness of the sclera. This thinning can be accomplished by paring or by abrading the surface or by ablating the surface with laser irradiation. The sclera can also be weakened by incisions carefully placed at appropriate angles in the region overlying the ciliary body. . . . Alternatively the sclera in the region overlying the ciliary body can be weakened by irradiation with a laser beam to

Any irradiative treatment with ionizing or non-ionizing radiation that weakens the sclera may be used. For example irradiation with electrons, protons, or x-rays and the like, or irradiation with ultrasonic waves or the like can be used. Thermal burning and/or scarring in the appropriate area may also be used to induce an enlargement of the sclera in the area adjacent to the ciliary body.

Any irradiative treatment with ionizing or column 8, non-ionizing radiation that weakens the sclera may be used. For example irradiation with electrons, protons, or X-rays and the like, or irradiation with ultrasonic waves or the like can be used. Thermal burning and/or scarring in the appropriate area may also be used to induce an enlargement of the sclera in the area adjacent to the ciliary body.